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EXAMINER

PYZOCHA, MICHAEL J

ART UNIT PAPER NUMBER

2137

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,175

Applicant(s)

VANDER KAMP, KERRY B.

Examiner

Michael Pyzocha

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-14 and 16-19 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 2, 4-14, and 16-20 are pending.
2. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 03/30/2006 has been entered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 6-7, 14, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Girard (US 20030097585).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As per claims 1-2, 6-7, 14 and 17 Girard discloses a system and method including determining whether a hard drive is locked; if the hard drive is locked, requesting a password from a BIOS during a boot sequence of a device, after loading an operating system kernel; receiving the password from the BIOS; checking the password for validity; and if the password is valid, unlocking the hard drive with the password by determining if the hard drive is locked and using drivers (see paragraphs 20-22, and 25).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2137

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2, 6-7, 14, and 17 are rejected under 35

U.S.C. 103(a) as being unpatentable over Kugue (US 5911042) in view of Lienbow (US 6012146).

As per claims 1-2, 6-7, 14 and 17, Kugue discloses a system and method including determining whether a hard drive is locked (see column 12 lines 3-4); if the hard drive is locked, requesting a password from a BIOS, after loading an operating system kernel; receiving the password from the BIOS (see column 12 lines 3-14); checking the password for validity; and if the password is valid, unlocking the hard drive with the password by determining if the hard drive is locked and using drivers (see column 12 lines 15-39).

Kugue fails to disclose performing password authentication during a boot sequence.

However, Lienbow teaches performing password authentication during a boot sequence (see column 3 lines 1-10).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to

Art Unit: 2137

Motivation to do so would be to protect data on a storage medium (see Lienbow column 2 lines 1-7).

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Kugue and Lienbow system in view of Herbert et al (US 5757919).

As per claim 4, the modified Kugue and Lienbow system fails to disclose loading the kernel from flash memory. However, Herbert et al teaches such loading (see column 2 lines 39-53).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to load the kernel of the modified Kugue and Lienbow system from flash memory.

Motivation to do so would have been allows all basic operations to be performed without external intervention (see column 2 lines 39-53).

8. Claims 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Kugue and Lienbow system as applied to claims 1 and 14 above, and further in view of "OEM Manual" (Hereinafter OEM).

As per claims 5 and 16, the modified Kugue and Lienbow system fails to disclose freezing a lock mechanism to prevent tampering with security parameters. However, OEM teaches such a limitation (see page 80).

Art Unit: 2137

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use OEM's freeze lock feature in the modified password protected hard drive system of the modified Kugue and Lienbow system.

Motivation to do so would have been to reject any other commands to update the device lock functions (see page 80).

9. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Kugue and Lienbow system as applied to claim 7 above, and further in view of Parzych et al (US 5375243).

As per claims 9-10, the modified Kugue and Lienbow system fails to disclose the password being a serial number and being encrypted. However, Parzych et al teaches such a password (see column 4 lines 30-48).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Parzych et al's password in the modified Kugue and Lienbow system.

Motivation to do so would have been to allow a dealer as well as a user to access the system.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Kugue and Lienbow system as applied to claim 7 above, and further in view of "Dell PowerEdge

Art Unit: 2137

7150" (hereinafter Dell) and further in view of McNabb et al (US 6289462).

As per claim 8, the modified Kugue and Lienbow system fails to disclose a chassis intrusion mechanism to alternate between a secure mode and a maintenance mode, wherein the hard drive remains password protected in both the secure mode and the maintenance mode. However, Dell teaches a chassis intrusion mechanism (see page 6) and McNabb et al teaches a secure mode and a maintenance mode (see column 11 line 66 through column 12 line 14).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Dell's chassis intrusion mechanism to switch between McNabb et al's modes and to use this system in the hard drive protection system of the modified Kugue and Lienbow system.

Motivation to do so would have been to know when the chassis is open (see page 6) and to have the ability to indicate which mode the system is in (see column 12 lines 1-14).

11. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Kugue, Lienbow, Dell, and McNabb et al system as applied to claim 8 above, and further in view of Parzych et al (US 5375243).

As per claims 11 and 13, the modified Kugue, Lienbow, Dell, and McNabb et al system fails to disclose the password being a serial number and being encrypted. However, Parzych et al teaches such a password (see column 4 lines 30-48).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Parzych et al's password in the modified Kugue, Lienbow, Dell, and McNabb et al system.

Motivation to do so would have been to allow a dealer as well as a user to access the system.

As per claim 12, Applicant is directed to Girard similarly applied as to in claim 1.

12. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Kugue and Lienbow system as applied to claim 17 above, in view of Liebenow.

As per claims 18-19, the modified Kugue and Lienbow system fails to disclose the accessing is done after a system interrupt. However Liebenow teaches such accessing (see column 3 lines 11-25).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to access the password of the modified Kugue and Lienbow system after an interrupt.

Motivation to do so would have been to protect the system when the hard drive powers down (see column 3 lines 11-25).

Allowable Subject Matter

13. Claim 20 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter: the prior art does not teach specifically loading an operating system kernel in less than three seconds.

Response to Arguments

15. Applicant's arguments, see page 8, filed 03/30/2006, with respect to the 103(c) exception have been fully considered and are persuasive. The rejections under 35 USC 103 based on the Girard reference of claims 5, 8-13, 16, and 18-19 has been withdrawn.

16. Applicant's arguments filed 03/30/2006 have been fully considered but they are not persuasive. Applicant argues that

Art Unit: 2137

the Girard reference is not "by another" because of a common assignee and therefore does not qualify as prior art. However, according to MPEP section 2136.04: "Another" means other than applicants, *In re Land*, 368 F.2d 866, 151 USPQ 621 (CCPA 1966), in other words, a different inventive entity. The inventive entity is different if not all inventors are the same. The fact that the application and reference have one or more inventors in common is immaterial. *Ex parte DesOrmeaux*, 25 USPQ2d 2040 (Bd. Pat. App. & Inter. 1992). In the present case there are no common inventors with the Girard reference and therefore constitutes "by another" and can be used as prior art under 35 USC 102(e). This rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

In order to expedite prosecution new rejections of the claims anticipated by Girard have been made in anticipation of Applicant submitting the above evidence to overcome the Girard reference.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cromer et al (US 20020166072) discloses a method for protecting devices with a password in the BIOS.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP


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